

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: First Draft, Inc.
Serial No.: 76/420,605
Mark: **FERN MICHAELS**
Filed: June 13, 2002
Final Office Action: November 20, 2003
Trademark
Examining Attorney: Naakwanma Ankrah, Law Office 106



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Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

December 9, 2004

REPLY BRIEF ON APPEAL

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22313-1451, on December 9, 2004

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REPLY BRIEF ON APPEAL

Applicant submits to the Trademark Trial and Appeal Board ("TTAB") this Reply Brief to the Trademark Examining Attorney's Appeal Brief. The Trademark Examining Attorney's Appeal Brief simply reiterates, virtually verbatim, the arguments presented by the prior Examining Attorney in the Office Actions of record¹ but fails to address any of the arguments and factual evidence submitted in Applicant's Brief on Appeal. Thus, in view of her failure to address Applicant's arguments, the Trademark Examining Attorney has conceded the arguments Applicant submitted in its Brief on Appeal. Accordingly, Applicant submits that the refusal to register Applicant's applied for mark must be reversed.

¹ Applicant is cognizant that, where appropriate, arguments that were made in earlier office actions may be repeated in the Trademark Examining Attorney's Appeal Brief in whole or in part. In the present matter, however (as shown below), the entire "Argument" repeats these arguments and does nothing more.

A full description of the record of this application is set forth in Applicant's Brief on Appeal, filed on September 14, 2004, and is hereby incorporated by reference. In its Brief, Applicant argued that the refusal to register the mark **FERN MICHAELS**, the pen name of a best-selling author of romance novels, should be reversed because:

- A. An author's name is registrable as a trademark when used for a series of books where the mark serves a dual function, *i.e.*, it also serves as an identifier of the products.
- B. An author's name is registrable when used with a series of books as demonstrated by the records of the Patent and Trademark Office.

In support of its position, Applicant distinguished the principal cases relied upon by the prior Trademark Examining Attorney, *In re Chicago Reader, Inc.*, 12 USPQ2d 1079 (TTAB 1989) and *Norcross v. Richardson*, 68 USPQ 371 (Com'r Pat. 1946), *aff'd*, 78 USPQ 122 (DC 1948), in support of her contention that an author's name can never function as a trademark. Applicant further argued that the reasoning of *In re Wood*, 217 USPQ 1345 (TTAB 1983), controlled the issue of registrability of Applicant's mark.

Applicant further argued that the reasoning permitting the registration of the name of musical groups to designate a series of musical recordings, as determined by the Court of Appeals for the Federal Circuit in *In re Polar Music International AB*, 714 F.2d 1567 (CAFC 1983) and confirmed by the TTAB in *In re Spirer*, 225 USPQ 693 (TTAB 1985), was applicable to determining the registrability of Applicant's mark.

In addition to the foregoing legal arguments, Applicant discussed in detail the records of seven third party registrations (and their respective file wrappers) of author's names, that are of

record in this appeal. These registrations confirm that the Patent and Trademark Office has a policy of permitting the registration of author's names, to designate a series of books, under circumstances substantially identical to those presented in Applicant's application. Applicant's Brief further specifically addressed the comments of the previous Trademark Examining Attorney as to the relevance and weight that should be accorded these registration.

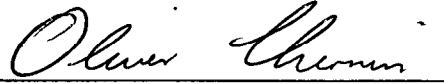
On November 26, 2004, the present Trademark Examining Attorney submitted her Appeal Brief in this matter to the TTAB. As noted, this Brief does not address any of the arguments advanced by Applicant; rather, it is a virtually verbatim repeat of the arguments made by the prior Trademark Examining Attorney in the Office Actions of record, all of which were addressed in Applicant's Brief on Appeal.

Specifically, in the Trademark Examining Attorney's Appeal Brief's "Argument" section, each and every paragraph of subsections A and B, as well as the first paragraph of subsection C, are identical to the language used in the "Final" Office Action dated November 20, 2003. Similarly, the final three paragraphs of subsection C of the Trademark Examining Attorney's Appeal Brief's "Argument" are verbatim repeats of the July 14, 2004 Office Action.

As the Trademark Examining Attorney's Appeal Brief merely reiterates the arguments that Applicant has already addressed in its Brief on Appeal, Applicant will rely on its prior submission. However, as the Trademark Examining Attorney's Appeal Brief fails to address Applicant's arguments, Applicant submits that they have been conceded.

In view of the foregoing, Applicant respectfully submits that the applied for mark **FERN MICHAELS** is entitled to registration for a series of books and that the refusal to register should be reversed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Oliver R. Chernin", is positioned above a horizontal line.

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